UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,766	09/10/2003	Rainer Barth	BARTH-2	4858

7590 04/09/2007	EXAMINER
Henry M. Feiereisen 350 Fifth Avenue Suite 4714 New York, NY 10118	NAUROT TON, JOAN

ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	**Applicant(s)**
Office Action Summary		10/659,766	BARTH, RAINER
		Examiner	**Art Unit**	
		Joan B. Naurot Ton	2109	.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☒ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☒ Certified copies of the priority documents have been received in Application No. 10/659,766.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *02/23/2004 and 09/10/2003*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This first office action is in reply to Application number 10/659766, filed on

September 10, 2003.

1.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application

No.10/650766, filed on September 10, 2003.

Claim Objections

2.   Claims 1, 2, 4, and 5 are objected to because of the following informalities:

Regarding claim 1:

On line 8: "receiver-specific to a Web server" should be changed to –to a

specified receiver of a Web server--.

On line 9, "an event" should be changed to –the specified event--.

On line 9, "a message" should be changed to –one of the messages--.

On line 10, "the message" should be changed to –one of the messages--.

Regarding claim 2:

On line 2, "an Internet browser" should be changed to –the Internet browser--.

Regarding claim 4:

On line 1, "the message" should be changed to –one of the messages--.

Regarding claim 5:

On line 1, "an e-mail message" should be changed to –the e-mail message--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Regarding claim 6, the words "such as machine status, status and process

information, as well as file attachments which are stored in the database" fails to point

out applicant's invention since the words "such as" is used.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

6.   Claims 1-11 are rejected because the claimed invention is directed to non-

statutory subject matter. In this case, in claims 1 and 11, the receiving of information is

non-statutory because there is no work being done on the message after it is being

received, and thus does not produce a tangible output result. The dependent claims 2-

10 do not fix the abstractions of claim 1, and thus are also directed towards non-

statutory subject matter.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

7.   Claims 1-7 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by

Araujo et al (US patent number 6920502, dated July 19, 2005, and filed on July 17,

2001).

Regarding claim 1:

Araujo discloses the method for transmitting messages from an industrial

controller to a specified receiver using an Internet-related protocol, comprising the steps

of: generating with an alarm indicating system, if a specified event occurs, event-

relevant information ("In the event of a detected fault or failure condition in any

monitored entity, the SEP (service enablement platform) generates a corresponding

alarm and reports it..." Column 8, lines 55-57); writing the event-relevant information to

a database accessible to the specified receiver ("...RMM process 2020 also records all

alarms it receives in a local database." Column 38, lines 34-35, and the receiver can

access the alarm information through a web site, i.e. "delivering alarms to web site

(CCC) 20". Column 38, lines 28-29); transmitting receiver-specific to a Web server out

of the event-relevant information only a message indicating that an event has occurred

(the receiver can access the alarm information through a web site, i.e. "delivering

alarms to web site (CCC) 20". Column 38, lines 28-29); and receiving the message at

the specified receiver, with the specified receiver accessing the event-relevant

information in the database via a cryptographically protected communication protocol

based on an Internet browser ("implements the necessary cryptographic and packet

processing operations", Column 3, lines 37-38. and "SEP can establish a web

connection with site 20 through which the SEP can report its operational data and/or

any alarm condition..." Column 36, lines 26-29.)

Regarding claim 2:

Araujo also discloses the limitations of claim 2 wherein the cryptographically

protected communication protocol implemented in an Internet browser comprises a

"Hypertext Transfer Protocol Security" protocol ("establishing a secure web (HTTPS)

connection to a web server implemented on SEP 200" Column 14, lines 47 and 48-49).

Regarding claim 3:

Araujo also discloses the limitations of claim 3 wherein the "Hypertext Transfer

Protocol Security" protocol comprises a "Secure Socket Layer" protocol or a "Transport

Layer Security" protocol. ("secured through SSL, with the CCC (Customer Care Center),

Column 9, line 51)

Regarding claim 4:

Araujo also discloses the limitations of claim 4 wherein the message is

transmitted to the specified receiver as an e-mail, an SMS or as a voice message

("email" is accessed through the Service Enablement Platform (SEP), Column 1, line

36, and the SEP also reports alarm messages, Column 36, lines 26-29).

Regarding claim 5:

Araujo also discloses the limitations of claim 5 wherein an e-mail message

includes a cross-reference, in particular a URL address, that provides a link to the

receiver-specific information that is stored in the database (The SEP (services

enablement platform) enables email modules to accept as input and output a URL

selection. Column 8, lines 26-35, and "Database 1420" ..."stores information for each

SEP then in service, alarm reports generated by each SEP and other related status as

provided by that SEP..."Column 16, lines 14-18).

Regarding claim 6:

Araujo also discloses the limitations of claim 6 wherein the event-relevant

information comprises event messages, fault messages and additional information,

such as machine status, status and process information ("In the event of a detected

fault or failure condition in any monitored entity, the SEP generates a corresponding

alarm and reports it..."), as well as file attachments which are stored in the database

("module then writes, ...the alarm information into CCC database" Column 44, lines 56

and 58).

Regarding claim 7:

Araujo also discloses the limitations of claim 7 wherein access to the Web server

is protected by a login prompt and a password ("...the CCC will send the SEP

appropriate login and password for a customer WAN account which that the SEP is to

use." Column 9, lines 42-44).

Regarding claim 11:

Araujo discloses the method for transmitting messages from an industrial

controller to a specified receiver using a modem connection ("modem" Column 16, line

49) protected by an authentication protocol ("HTTP authentication" Column 9, line 33),

comprising the steps of: generating with an alarm indicating system, if an event occurs,

event-relevant information ("In the event of a detected fault or failure condition in any

monitored entity, the SEP (service enablement platform) generates a corresponding

alarm and reports it..." Column 8, lines 55-57); writing the event-relevant information to

a database accessible to the specified receiver ("...RMM process 2020 also records all

alarms it receives in a local database." Column 38, lines 34-35, and the receiver can

access the alarm information through a web site, i.e. "delivering alarms to web site

(CCC) 20". Column 38, lines 28-29); transmitting receiver-specific via the modem

connection out of the event-relevant information only a message indicating that an event

has occurred (the receiver can access the alarm information through a web site, i.e.

"delivering alarms to web site (CCC) 20". Column 38, lines 28-29); and receiving the

message at the specified receiver, with the specified receiver accessing the event-

relevant information in the database via a cryptographically protected communication

protocol via the modem connection ("implements the necessary cryptographic and

packet processing operations", Column 3, lines 37-38, using a "modem", Column 16,

line 49, and "SEP can establish a web connection with site 20 through which the SEP

can report its operational data and/or any alarm condition...", Column 36, lines 26-29.)

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Araujo in view of Crater et al (US Patent number 6201996, dated March 13, 2001),

hereinafter referred to as Crater.

Regarding claim 8:

Araujo discloses all the limitations of claim 8 except for wherein at least one of the

database and the Web server are integrated with hardware of the controller.

Crater discloses "the present invention combines the immediacy and flexibility of

web access to industrial controllers...to achieve a highly integrated system amenable to

ready customization and modification." Column 3, lines 58-62. Crater also discloses

that his "control structure may be organized around a database", abstract, lines 4-5)

The general concept of integrating components to the hardware of the controller

is well known in the art as illustrated by Crater which discloses a component integration

in a controller method.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Araujo to include the use of integrating components to the controller

hardware in his advantageous method as taught by Crater so that the controller

"facilitates selection and performance of actions in the database" as stated by Crater on the last 3 of four lines in his abstract.

Regarding claim 9:

Araujo discloses all the limitations of claim 9 except for wherein at least one of the database and the Web server are implemented as hardware that is separate from hardware of the controller.

Since Crater's method is amenable to ready customization and modification, Column 3, lines 61-62, Crater's method can separate the hardware of the controller from at least one of the database and Web server hardware.

The general concept of modifying and customizing a database to be separate from the hardware of the controller is well known in the art as illustrated by Crater which discloses modifying and customizing a system. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Araujo to include the modification of separating the controller hardware from the database in his advantageous method as taught by Crater in order to "achieve a highly integrated system amenable to ready customization and modification." as stated by Crater in Column 3, lines 58-62.

9.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crater in view of Lo (US publication 2003/0061274, dated March 27, 2003, and filed on September 24, 2001).

Regarding claim 10:

Crater discloses all the limitations of claim 10 except for wherein at least one of

data, parameters and programs for the controller are transmitted from the specified receiver to the controller.

Lo discloses that his method has the capability of programming with the aid of a client through a web browser the programming code for the controller, abstract, lines 2-10.

The general concept of sending programs from a receiver to a controller is well known in the art as illustrated by Lo which discloses a client device which programs a controller in a programmable controller. It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Crater of in his advantageous controller method as taught by Lo in order to provide a "new business paradigm" for programmable controllers and their customers as stated by Lo on lines 13-15 of his abstract.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan B. Naurot Ton whose telephone number is 571-270-1595. The examiner can normally be reached on M-Th 9 to 6:30 (flex sched) and alt Fridays off.
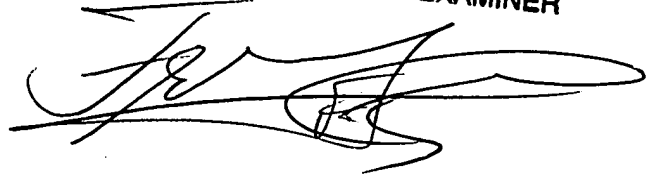
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on 571-272-6681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBNT
3/30/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER